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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/503,110	02/14/2000	Takeshi Aimoto	500.35180CX1	6112

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EXAMINER

EMDADI, KAMRAN

ART UNIT

PAPER NUMBER

2667

DATE MAILED: 08/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/503,110	AIMOTO, TAKESHI	
	Examiner Kamran Emdadi	Art Unit 2667	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 14 February 2000.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

4) Claim(s) 1-29 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-29 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3-10 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Regarding claim 3, "stepwisely" is not understood by the examiner. The specification cites with respect to the term in question:

"The node stepwisely changes a cell discard priority class, for example, in accordance with the congestion status, and determines whether or not each cell belonging to the particular traffic class is discarded in conformity to a predetermined discard condition determined by the priority and the cell discard priority class."

It is unclear how this word effects the definition of changing a cell discard priority, the word will be omitted from the examination process when interpreting the claim language. Appropriate correction is required.

4. Regarding claim 29, "higher rank protocol" is not described in the specification in such a way to convey a reasonable explanation to the examiner regarding the higher ranking portion of the protocol, and what protocols are assumed as part of the rank? Appropriate action is required.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

6. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).
7. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).
8. Claims 11-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, and 5-17 of U.S. Patent No. 6041038 (Aimoto). Although the conflicting claims are not identical, they are not patentably distinct from each other because.
  - The following claims are paired as being taught by Aimoto in the order of: (applicants claim(s), corresponding Aimoto patented claim(s)).
  - Claims:
    - ((11 and 12), 1)
    - Claim 11 is a device much the same as claim 1, however the Aimoto does not teach "storing information indicative of a priority" Aimoto does teach in claim 1, "congestion status information and the priority" as used in the same context and it would be obvious to one of ordinary skill to store the priority information that is to be used at a later time to make a comparison. Also the

means for selectively discarding is written in a different format but all of the limitations are taught by claim 1 in the Aimoto reference.

- Claim 12 is much the same as claim 1 in its entirety in the Aimoto reference, the differences are: the Aimoto reference uses plural input and output lines as opposed to output/input line interfaces, and because this is the only noticeable difference in the comparison of the two claims, claim 12 is obviously an alternate version of the same patented claim 1 in the Aimoto reference.
- (13 , 2) Claims 13 and 2 contain no noticeable differences when comparing the claim language.
- (14, 7) Claims 14 and 7 contain no noticeable differences when comparing the claim language.
- (15, 8) Claims 15 and 8 contain no noticeable differences when comparing the claim language.
- (16, 5) Claims 16 and 5 contain no noticeable differences when comparing the claim language.
- (17, 6) Claims 17 and 6 contain a substitution of the word "judge" in claim 17 for the word "determine" in claim 6, no other noticeable differences are present when comparing the claim language, therefore it would be obvious to substitute a word that is accomplishing the same goal.
- (18, 7) Claims 18 and 7 contain no noticeable differences when comparing the claim language.

- (19, 8) Claims 19 and 8 contain no noticeable differences when comparing the claim language.
- (20, 9) Claims 20 and 9 contain no noticeable differences when comparing the claim language.
- (21, 10) Claims 21 and 10 contain no noticeable differences when comparing the claim language.
- (22, 11) Claims 22 and 11 contain no noticeable differences when comparing the claim language.
- (23, 12) Claims 23 and 12 contain no noticeable differences when comparing the claim language.
- (24, 13) Claims 24 and 13 contain no noticeable differences when comparing the claim language.
- (25, 14) Claims 25 and 14 contain a substitution of the word “judge” in claim 25 for the word “determine” in claim 6, no other noticeable differences are present when comparing the claim language, therefore it would be obvious to substitute a word that is accomplishing the same goal.
- (26, 15) Claims 26 and 15 contain no noticeable differences when comparing the claim language.
- (27, 16) Claims 27 and 16 contain no noticeable differences when comparing the claim language.
- (28, 17) Claims 28 and 17 contain no noticeable differences when comparing the claim language.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1 - 4, 11 are rejected under 35 U. S. C. 103 (a) as being unpatentable over Katsube et al. (US Patent No. 5267232)

- Regarding claim 1, Katsube teaches: a cell transfer control method in an ATM system (Col 2, lines 60-64), (Figures 12 (a-c)), without making bandwidth reservations (Col 5, lines 53-58), where the control and transmitting information relating to cells are stored in the VC table 200 where the table is stored at all of the communication nodes (Col 8, lines 1-7), when congestion occurs selective discarding is implemented in accordance with a predetermined discard priority (Col 5, lines 25-30), a plurality of input and output ports (Figure 9), a cell transfer control method comprising the steps of Storing information indicative priority related to cell discard and performing selective discard process on cells depending on the status of congestion and priority (col. 1, lines 54-64). Even though, Katsube does not teach controlling cell loss priority level specifically for the connection without bandwidth reservation. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to realize that the method for selectively discarding cells depending on cell priority and

network congestion is usable to the network connection without bandwidth reservation because when the network congestion occurs, the network without bandwidth reservation also discard the cells just as the network with bandwidth reservation. The method taught by Katsume would help minimizing communication degrading for the network without bandwidth reservation.

- Regarding claim 2, Katsume teaches that an ATM switching device comprising plurality of input ports and output ports (Fig. 9).
- Regarding claim 3, Katsume teaches changing a cell discard priority class and determining whether or not the cell is discarded (col. 5, lines 27-31).
- Regarding claim 4, refer to discussion in claim 2 above.
- Regarding claim 11, since Katsume teaches a method for controlling cells transfer as discussed in claim 1, he provides the means to perform the method as claimed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamran Emdadi whose telephone number is (703) 305-4899. The examiner can normally be reached between the hours of 8am and 5pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham, can be reached at (703) 305-4378. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9314 for regular communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Kamran Emdadi

08/07/2003



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